

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD D. FERRIS

Appeal 2007-2848
Application 10/765,106
Technology Center 3700

Decided: September 20, 2007

Before DEMETRA J. MILLS, ERIC GRIMES, and RICHARD M.
LEBOVITZ, *Administrative Patent Judges*.

MILLS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 1-15, the only
claims pending in this application. We have jurisdiction under 35 U.S.C. §
6(b).

The claims read as follows:

1. A putter type golf club including a club head having a ball striking face lying in a first plane and a shaft having an upper end and a lower end connected to the club head, wherein the improvement comprises:

an elongated handle having an upper edge and a lower edge, said handle being attached to said shaft and having a generally oval, cross-sectional shape along the entire handle between said upper edge and said lower edge;

said generally oval, cross-sectional shape of said elongated handle including a first rounded front edge and a second rounded rearward edge defining a cross-sectional, length dimension of said handle; a first flat side surface and a second opposing flat side surface defining a width dimension of said handle; said cross-sectional, length dimension being perpendicular to said first plane of said ball striking face; said handle being further defined by said first rounded forward edge having a first radius and said second rounded rearward edge having a second smaller radius; said flat side surfaces gradually tapering closer, each to the other, in a forward to rearward edge direction; said upper edge of said handle including alignment indicia thereon, defined by at least a first alignment line in the direction perpendicular to the first plane of said ball striking face and a second alignment line on said upper edge of said handle, said second alignment line being perpendicular to said first alignment line, parallel to said first plane of said ball striking face; and wherein said first alignment line and said second alignment line intersect to form four angles.

2. The putter type golf club of claim 1 wherein said upper edge of said handle is further defined by a flat upper surface.

3. The putter type golf club of claim 1 wherein said handle extends at least half of the overall length of the golf club from said club head to said upper end of said shaft.

4. The putter type golf club of claim 1 wherein the first alignment line is longer than the second alignment line.

5. The putter type golf club of claim 1 wherein the first alignment line and second alignment line intersect to form a cross.

6. A putter type golf club including a club head having a ball striking face lying in a first plane and a shaft having an upper end and a lower end connected to the club head, wherein the improvement comprises: an elongated handle having an upper edge and a lower edge, said handle being attached to said shaft and having a generally oval, cross-sectional shape along the entire handle between said upper edge and said lower edge; said upper edge of said handle including alignment indicia, defined by at least a first alignment line in a direction perpendicular to the first plane of said ball striking face and a second alignment line on said upper edge of said handle, said second alignment line being perpendicular to said first alignment line, parallel to said first plane of said ball striking face; and wherein said first alignment line and said second alignment line intersect to form four angles.

7. The putter type golf club of claim 6 wherein said upper edge of said handle is further defined by a flat upper surface.

8. The putter type golf club of claim 6 wherein said handle extends at least half of the overall length of the golf club from said club head to said upper end of said shaft.

9. The putter type golf club of claim 6 wherein the first alignment line is longer than the second alignment line.

10. The putter type golf club of claim 6 wherein the first alignment line and second alignment line intersect to form a cross.

11. A putter type golf club including a club head having a ball striking face lying in a first plane and a shaft having an upper end and a lower end connected to the club head, wherein the improvement comprises: an elongated handle having an upper edge and a lower edge, said handle being attached to said shaft; said upper edge of said handle including alignment indicia, defined by at least a first alignment line in a direction perpendicular to the first plane of said ball striking face and a second alignment line on said upper edge of said handle, said second alignment line being perpendicular to said first alignment line, parallel to said first plane of said ball striking face; and wherein said first alignment line and said second alignment line intersect to form four angles.

12. The putter type golf club of claim 11 wherein said upper edge of said handle is further defined by a flat upper surface.

13. The putter type golf club of claim 11 wherein said handle extends at least half of the overall length of the golf club from said club head to said upper end of said shaft.

14. The putter type golf club of claim 11 wherein the first alignment line is longer than the second alignment line.

15. The putter type golf club of claim 11 wherein the first alignment line and second alignment line intersect to form a cross.

Cited References:

Dishner	US 4,426,083	Jan. 17, 1984
Takeuchi	US 5,058,891	Oct. 22, 1991
Radakovich	US 5,152,533	Oct. 6, 1992
Eberle	US 5,779,559	Jul. 14, 1998
Bloom	US 6,506,128 B1	Jan. 14, 2003
Cacicedo	US 6,511,386 B1	Jan. 28, 2003
Ferris	US 6,723,001 B2	Apr. 20, 2004

Grounds of Rejection

1. Claims 1-15 stand rejected under to doctrine of obviousness-type double patenting over claims 1-5 of U.S. Patent No. 6,723,001.

2. Claims 1, 2, 4 and 5 stand rejected under 35 U.S.C. § 103(a) as obvious over Cacicedo in view of Bloom, Radakovich, and Takeuchi (Answer 5).

3. Claim 3 stands rejected under 35 U.S.C. § 103(a) as obvious over Cacicedo in view of Bloom, Radakovich, Takeuchi, and further in view of Eberle or Dishner (Answer 8).

4. Claims 6, 7, 9 and 10 stand rejected under 35 U.S.C. § 103(a) as obvious over Bloom in view of Radakovich and Takeuchi (Answer 8).

5. Claim 8 stands stand rejected under 35 U.S.C. § 103(a) as obvious over Bloom in view of Radakovich, and Takeuchi, and further in view of Eberle or Dishner (Answer 10).

6. Claims 11, 12, and 15 stand rejected under 35 U.S.C. § 103(a) as obvious over Radakovich and Takeuchi (Answer 11)

7. Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Radakovich in view of Takeuchi, Eberle or Dishner.

8. Claim 14 stands rejected under 35 U.S.C. § 103(a) as obvious over Radakovich and Takeuchi, and further in view of Bloom.

DISCUSSION

Background

The Specification discloses what is said to be an improved golf putter grip/handle having a unique oval configuration which promotes improved and consistent stroke control, stroke direction and distance to facilitate predictable accurate and successful putting. (Specification 4.) “The upper surface [of the club] includes alignment marks. The alignment marks are in the shape of a cross-hair, with a first line being located along the longer elongated or longitudinal axis of the oval in a direction toward the target and a second shorter line, crossing the first line, in a direction perpendicular to the target line.” (Specification 4-5.)

Obviousness-type Double Patenting

Claims 1-15 stand rejected under to doctrine of obviousness-type double patenting over claims 1-5 of U.S. Patent No. 6,723,001.

The Examiner contends:

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-5 of U.S. Patent No. 6,723,001 have the ratio of the width to the length and a club being a putter as the only differences. The ratio is the feature which made claims 1-5 of U.S. Patent No. 6,723,001 allowable. As such it would be obvious to remove this element of structure since all ovals with [sic] have a ratio of width to length and now the claims do not require it. Claims 1-2 of this application contain all the elements of structure which where [sic] claimed in claims 1, and 4-5 of patent 6,723,001.

(Answer 4-5.)

Appellant contends that all of the pending claims include an alignment system limitation with a distinct shape over that claimed in U.S. Patent No. 6,723,001 ('001). (Br. 7.) The Examiner rebuts this argument, stating that the alignment system of claim 5 of the '001 patent comprises cross hairs with a first line bisecting the forward and rearward edges with a second line perpendicular to the first line. (Answer 22-23.)

“A later . . . claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim.” *See Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 968, 58 USPQ2d 1869, 1878 (Fed. Cir. 2001) *See also In re Goodman*, 11 F.3d 1046, 1053, 29 USPQ2d 2010, 2016 (Fed. Cir. 1993) (“[The application claims] are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is ‘anticipated’ by the species of the patented invention.

This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic application.”).

Claim 1 of the U.S. Patent No. 6,723,001 ('001) is directed to a golf club with an oval handle, but further requires:

said handle being further defined by said cross-sectional, length dimension of said oval, cross-sectional shape being at least 1.5 times greater than the largest width dimension between said side surfaces of said handle.

Claims 4 and 5 of the '001 patent further require a putter-type golf club having alignment indicia; claim 5 particularly covers (“first alignment line bisecting said oval shaped handle between said first rounded forward edge and said second rounded rearward edge in a direction perpendicular to said ball striking face and a second alignment line, perpendicular to said first alignment line”) an alignment indicia having four angles.

Instant claim 1 of the pending application recites that said upper edge of said handle including alignment indicia thereon, defined by at least a first alignment line in the direction perpendicular to the first plane of said ball striking face and a second alignment line on said upper edge of said handle, said second alignment line being perpendicular to said first alignment line, parallel to said first plane of said ball striking face; and wherein said first alignment line and said second alignment line intersect to form four angles.

Thus, claims 4 and 5 of the '001 patent meet the limitations of instant claim 1 of an indicia forming four angles. Appellant does not identify any other defect in the rejection, and as we find none, the obviousness-type double patenting rejection of claim 1 is affirmed. Claims 2-15 fall with

claim 1 because they were not argued separately. 37 C.F.R.
§ 41.37(c)(1)(vii).

Obviousness

Claims 1, 2, 4-7, 9-12 and 15

Claims 1, 2, 4 and 5 stand rejected under 35 U.S.C. § 103(a) as obvious over Cacicedo in view of Bloom, Radakovich, and Takeuchi. Claims 11, 12, and 15 stand rejected under 35 U.S.C. § 103(a) as obvious over Radakovich and Takeuchi. Claims 6, 7, 9 and 10 stand rejected under 35 U.S.C. § 103(a) as obvious over Bloom in view of Radakovich, and Takeuchi.

We select claims 1, 6 and 11 as representative of these rejections. 37 C.F.R. 41.37(c)(1)(vii).

The Examiner finds that

Cacicedo discloses a hand grip having an oval shape with a front edge having a larger radius than a rear edge (Fig. 10), an upper edge and a lower edge (Fig. 17), an oval cross section shape along substantially the entire handle between an upper and lower edge (Fig. 17), and a grip cap having no vent hole (Fig. 13) in order to establish a stiffness and feel to a hand grip (Abstract).

(Answer 5.)

The Examiner acknowledges that

Cacicedo lacks a putter, an oval cross section shape along the entire handle between an upper and lower edge, a length dimension being perpendicular to a first plane of a ball striking face, alignment indicia on an upper edge with a first alignment line in a direction perpendicular to a first plane of a ball striking face, a second alignment line being perpendicular to a first

alignment line, parallel to a ball striking face and a first alignment line and second alignment line intersecting to form four angles and a cross.

(Answer 5-6.)

To make up for the deficiencies of Cacicedo, the Examiner relies on Bloom.

Bloom discloses a putter (Fig. 4), an elongated axis of an oval, cross-sectional shape having a length being perpendicular to the plane of the ball striking face (Abstract), and an oval cross section shape along the entire handle between an upper and lower edge in order to have an ergonomic gripping surface that promotes a preferred palm and promotes proper hand and body placement (Abstract).

The Examiner concludes that

[i]n view of ... Bloom it would have been obvious to modify the club of Cacicedo to include a putter in order to utilize the advantages of establishing a stiffness and feel to a handgrip for a putter. In addition, in view of ... Bloom it would have been obvious to modify the club of Cacicedo to have an elongated axis of an oval along the entire handle between an upper and lower edge, cross-sectional shape having a length being perpendicular to the plane of the ball striking face in order to promote a preferred palm and ... proper hand and body placement along the handle and in order to have the same feel along the entire length of a grip.

(Answer 6.)

The Examiner further relies on Radakovich as teaching a sighting device and Takeuchi for the disclosure of alignment lines for grip positioning. (See Answer pages 6-7.) In particular, Radakovich describes indicia on a sticker which is placed on a butt end of a grip,

in order to improve accuracy by improving alignment and control of a ball striking face, and also describes a grip able to be used with a putter. (*Id.*) Takeuchi discloses alignment lines for grip positioning on a shaft, placed on a flat or rear end surface of a grip and indicia substantially filling up the entire length and width of a grip top flat surface except the center (Fig. 5). (Answer 7.)

The Examiner concludes in view of the disclosure of Radakovich that it would have been obvious to modify the putter of Cacicedo to have a sighting device placed on a flat surface of a grip end ... in order to assist a golfer in improving accuracy by improving alignment and control of a face of a club. In view of the patent of Radakovich and Takeuchi it would have been obvious to modify the putter of Cacicedo to have the alignment lines being indicia and taking up the entire length, width and center of a grip top flat surface and a first alignment line and second alignment line intersecting to form four angles and a cross in order to minimize the number of parts needed for a grip by having indicia and in order to be more visually visible for a golfer by using the entire surface for the alignment indicia. As such for an oval shaped grip a first alignment line will be longer than a second alignment line.

(Answer 7.)

In order to determine whether a prima facie case of obviousness has been established, we consider the factors set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1996); (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the relevant art; and (4) objective evidence of nonobviousness, if present. We additionally recognize that “[t]he Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art,” and “may not

disregard claim limitations comprised of printed matter.” *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) (citations omitted). In determining whether the printed matter imparts patentability to a claimed invention, however, “the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.” *In re Gulack*, 703 F.2d 1381, 1386, 217 USPQ 401, 404 (Fed. Cir. 1983).

Essentially, Appellant's alignment indicia at the butt end of the golf club is printed matter that has a functional relationship with the golf club, as it acts as a method to sight the ball to the target. However, we conclude the Examiner has provided sufficient evidence in the prior art to support a prima facie case of obviousness of a putter, as claimed, having alignment indicia on the butt end of a golf club.

Appellant contends that "all of these rejections are improper as Radakovich, when combined with Takeuchi, fails to meet all of the claimed limitations." (Br 8.) Appellant also argues that "[i]n addition to not disclosing the claimed invention, Radakovich and Takeuchi are focused upon different concepts relating to golf clubs, and in the Appellant's opinion are, therefore, not obvious to combine." (*Id.*) Appellant argues the alignment system of Radakovich is for sighting a club relative to a target and not for aligning a club relative to the ball. (Br. 9.)

We, therefore, focus our discussion primarily on whether Radakovich and Takeuchi teach the claimed aligning and sighting features of a putter type golf club. Appellant argues "Radakovich at best teaches a sighting device with meeting lines 92 and 94 (Fig. 4), but they do not intersect to form four angles as claimed." (Br. 9.) Appellant further contends that

"Takeuchi also fails to teach a cross or intersecting lines" in their sighting device. (Br. 10.) Appellant argues that upon reviewing Radakovich's Fig. 5 and the entire specification and drawings of Takeuchi, he can find no teaching of intersecting lines, nor intersecting lines forming four angles as claimed. (Br. 10.)

Takeuchi describes a fitting angle¹ adjustment mark for the end surface of a grip in the same position which is recited in claims 1, 4, 5, 6, 9, 10, 11, 14 and 15. Takeuchi Fig. 3 is reproduced below.

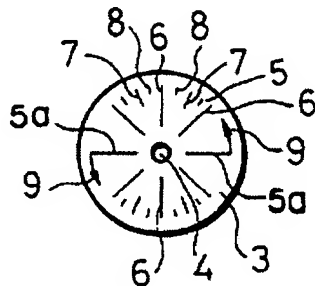


Fig. 3 shows the mark has radially extending grooves in the rear end surface of the grip which act as reference graduations. (Takeuchi, col. 2, ll. 49-53; col. 4, ll. 17-33.) The graduations include "great graduations at 45 degree intervals progressively from the reference graduation [5a]." (Takeuchi, col. 2, ll. 30-62; col. 4, ll. 17-25.) Because the great graduations are at 45 degree angles, the grooves making the graduations form four angle quadrants. While the grooves in Fig. 3 do not intersect in a cross, they do form four quadrants and performed the same function as the claimed indicia. There is no functional difference between the arrangement taught by Takeuchi and that recited in claim 1 other than a printed design feature (i.e.,

¹ A fitting angle is from the back line of the grip to the club face and must exactly match the angles desired by a golfer. Takeuchi, col. 1, ll. 30-32.

non-intersecting lines versus intersecting lines). Whether the lines intersect or not has no functional relationship with the substrate, and this we do not consider the difference to distinguish the claimed feature from that disclosed in Takeuchi.

“[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious” the relevant question is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR Int’l Co. v. Teleflex Inc.*, 127 Ct. 1727, 82 USPQ2d 1385 (2007). In the present case, the prior art of Takeuchi describes a sighting device forming four angle quadrants for the purpose of demarcating the target directional line. The fact that the 45 degree angles do not cross in the middle does not change the function of the sighting device fitted for the butt end of a golf club. The appearance of the angles is a stylized design choice that does not impart patentability to an otherwise obvious invention.

Furthermore, in *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions that would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. In the present case, extending the size of the graduations of the indicia and crossing them in the middle would not make the claimed putter sighting device

perform differently than that of Takeuchi. Radakovich similarly provides an angled sighting device.

Appellant argues his alignment system is for sighting the club relative to the ball. (Br. 9.) Appellant argues the alignment system of Radakovich is for sighting a club relative to a target and not for aligning a club relative to the ball. However, Radakovich states that its golf club sighting apparatus is for precise alignment of the golf club head to a golf ball for improving accuracy to a designated target. (Radakovich, col. 1, ll. 5-10.) Thus Radakovich's ultimate goal is to improve sighting and accuracy of the club head to the ball and the ball to the target. The fitting angle adjustment mark of Takeuchi is also to align the golfer's grip and provide an arrangement of the club in accordance with the golfer's usual hitting of the ball. (Takeuchi, col. 1, ll. 24-30.) Therefore, we are not persuaded by Appellant's argument that the sighting devices of the prior art are for different purposes.

This rejection is affirmed.

Claims 3, 8 and 13

Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Cacicedo in view of Bloom, Radakovich and Takeuchi and further in view of Eberle or Dishner. Claim 8 stands rejected under 35 U.S.C. §103(a) as obvious over Bloom in view of Radakovich, and Takeuchi, and further in view of Eberle or Dishner. Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Radakovich in view of Takeuchi, and further in view of Eberle or Dishner. Each of the claims require that the “handle

extends at least half of the overall length of the golf club from said club head to said upper end of said shaft.”

According to the Examiner, Cacicedo lacks a handle extending at least half of the overall length of the club from the head to the upper end of a shaft. (Answer 8.)

The Examiner relies on Eberle for the disclosure of a pendulum putter:

Eberle discloses an elongated handle having a generally oval, cross-sectional shape including rounded front and rear edges (Fig. 3), an elongated axis of an oval, cross-sectional shape being perpendicular to the plane of the ball striking face (Col. 3, Lns. 55-57), and a handle having a length approximately half the overall length of the golf club (Fig. 1) in order to have a pendulum type putter (Col. 1, Lns. 7-32).

(Answer 8.) The Examiner cites Dishner as disclosing

an elongated handle having a generally oval, cross-sectional shape including rounded front and rear edges (Fig. 3), and a handle having a length approximately half the overall length of the golf club (Figs. 5-6) in order to have a length adaptable to a wide variance of personal stances and physiognomy (Col. 4, Lns. 13-14).

(Answer 8.)

The Examiner concludes

it would have been obvious to modify the putter of Cacicedo to have a handle extending at least half of the overall length of the club from the head to the upper end of a shaft in order to be able to modify the stiffness and feel for a handle of a pendulum type putter and to have a length adaptable to a wide variance of personal stances and physiognomy.

(Answer 8.)

We find the Examiner has provided sufficient evidence in the prior art to support a prima facie case of obviousness, including motivation to combine the cited references.

Appellant contends, "both Cacicedo and Bloom are improperly relied upon to teach a handle having the same cross-sectional shape along its entire length." (Br. 13.) Appellant argues that the grip of Dishner is not oval but is circular, and the grip of Eberle is neither elliptical or oval. (Br. 13.) The Appellant concludes therefore, that no combination of the cited references meets the claimed shape. (*Id.*)

We are not persuaded by these arguments. Both Eberle and Dishner disclose a golf club handle for gripping the club which extends at least $\frac{1}{2}$ the length of the club. Dishner's Fig. 3 shows a club with an essentially oval cross sectional shape, wherein the length of the club adapts to a wide variance of personal stances and physiognomy. (Dishner, col. 4, ll. 11-14.) We find both Dishner and Eberle provide evidence in the prior art that one of ordinary skill in the art would have been motivated to modify the handle of Cacicedo to have a length adaptable to a wide variance of personal stances and physiognomy. In the present case, the extended handle length provides for adaptation of the club to a variety of stances and body types. Therefore extension of the handle length of Cacicedo would provide a predictable adaptation of the club to a variety of stances and body types in accordance with its established function. *KSR Int'l Co. v. Teleflex Inc.*, 127 Ct. 1727, 82 USPQ2d 1385 (2007).

The rejections of claims 3, 8, and 13 are affirmed.

Claim 14

Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Radakovich in view of Takeuchi and Bloom. Claim 14 further requires that “the first alignment line is longer than the second alignment line.”

The Examiner finds that Radakovich discloses an angled sighting device, however,

Radakovich lacks a first alignment line being longer than a second alignment line. Bloom discloses a putter (Fig. 4) with a cross section of a grip being oval with a major axis perpendicular to the face of head in order to have an ergonomic gripping surface that promotes a preferred palm and promotes proper hand and body placement (Abstract).

(Answer 13.)

The Examiner concludes

[i]n view of the patent of Bloom it would have been obvious to modify the putter of Radakovich to have a grip being an oval with a major axis perpendicular to the face of a head with the first alignment line along the major axis and the second alignment line along the minor axis in order to have a grip ... having an ergonomic gripping surface that promotes a preferred palm and promotes proper hand and body placement as well as alignment features a golfer is able to use when hitting a ball.

(Answer 13.)

Appellant argues that the cited references fail to describe indicia having intersecting lines wherein one line is longer than the other. (Br. 15.)

Claim 14 is directed to the printed form of the claimed lines and is therefore printed matter. In determining whether the printed matter imparts patentability to a claimed invention, however, “the critical question is

whether there exists any new and unobvious functional relationship between the printed matter and the substrate.” *In re Gulack*, 703 F.2d 1381, 1386, 217 USPQ 401, 404 (Fed. Cir. 1983).

In the present case, the prior art of Radakovich describes a printed matter sighting device and Takeuchi describes a sighting device forming four angle quadrants for the purpose of demarcating the target directional line. The fact that the 45 degree angles do not have intersecting lines wherein one line is longer than the other, does not change the function of the sighting device fitted for the butt end of a golf club. It would have been obvious to modify the indicia of Radakovich or Takeuchi to fit an elongated oval club butt for the stated function of providing a sighting guide for a golfer. While the grooves in Fig. 3 of Takeuchi do not intersect in a cross, they do form four quadrants and performed the same function as the claimed indicia. There is no functional difference between the arrangement taught by Takeuchi and that recited in claim 14 other than a printed design feature (i.e., non-intersecting lines versus intersecting lines, and the length of one line being longer than the other). Whether the lines intersect or not, or are of different lengths has no functional relationship with the substrate, and thus we do not consider it to distinguish the claimed feature from that disclosed in Takeuchi.

The obviousness rejection is affirmed.

CONCLUSION

The obviousness rejections are affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

dm

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